

Docket No. F-8624

Ser. No. 10/529,807

REMARKS

Claims 4-8 and 38-42 are now pending in this application and are rejected.

Claims 4 and 38 are amended herein to clarify the invention. New claims 73 and 74 are added herein to further clarify the distinction between the present invention and the cited art.

Claims 4-8 and 38-42 are rejected under 35 U.S.C. §102(b) as being anticipated by the Watanabe et al (Japanese Patent No. 6-7833).

Applicants respectfully assert that the claims are not anticipated by the cited art. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In the present invention, a low deformation resistance region is formed on a metal body by cooling the metal body at two spaced locations and heating the metal body at a third location which is *in between* the two spaced locations at which the metal body is cooled. Amendments to the claims remove the possibility of misinterpreting the forming, heating and cooling as separate steps.

Watanabe does not set forth a method of forming a metal body as recited in the claims. Watanabe states:

Docket No. F-8624

Ser. No. 10/529,807

Fig. 1 shows an extruding forming machine used in one embodiment. The extruding forming machine 20 shown in Fig. 1 extrudes aluminum alloy billet 3 of high strength into a predetermined cross-sectional shape from a forming die 21 by an extruding press 2 to form an extruded formed product 22. The extruded formed product 22 extruded from the forming die 21 is formed into an elongated shape while being held by a holding device 7 which moves the extruded formed product 22 in the extruding direction of the extruded formed product 22 along the guide rail 6. A temperature control device 23 for controlling temperature of the extruded formed product 22 which passes through the forming die 21 is mounted on the extruding forming machine 20. The controller 24 controls a heating operation by a heating applying member 28 mounted on the forming die 21 and a cooling operation by a cooling applying member 29 mounted on the forming die 21 in response to an output signal...

See Watanabe paragraph 11. Watanabe further elaborates:

By controlling the heating operation by the heating applying member 28 and the cooling operation by the cooling applying member 29, a temperature of a portion of the forming die 21 of the extruding forming machine 20 is controlled thus continuously forming a low-strength portion 22a having the coarse crystalline structure and a high-strength portion 22b having the fine crystalline structure in the extruded formed product 22 in the extruding direction of extruded formed product 22.

See Watanabe paragraph 15. From these two excerpts from Watanabe it is apparent that the heating applying member 28 and the cooling applying member 29 are essentially mounted together in the forming die 21. In other words, the heating and cooling applying members 28, 29 together control the temperature at a single location within the forming die 21, and not at spaced locations. Thus, the Watanabe apparatus only controls a temperature applied to a single portion of a formed product 22 that is in the forming die 21. It is also clear from Fig. 1 in Watanabe that the heating

RECEIVED
CENTRAL FAX CENTER

JAN 22 2008

Docket No. F-8624

Scr. No. 10/529,807

applying member 29 is not located *between* two cooling applying members 28. Therefore, the Watanabe apparatus is not capable of performing a method of heating a metal body at a location between two spaced locations where the metal body is cooled, as is recited in the claims. Thus, Watanabe is not an anticipatory reference.

Applicant respectfully requests a one month extension of time for responding to the Office Action. The fee of \$60 for the extension is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Docket No. F-8624

Ser. No. 10/529,807

Respectfully submitted,

JORDAN AND HAMBURG LLP

By C. Bruce Hamburg M. Zev Levoritz
C. Bruce Hamburg
Reg. No. 22,389
Attorney for Applicants
Reg. No. 50,151

and,

By M. Zev Levoritz
M. Zev Levoritz
Reg. No. 50,151
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340

Enc: Form PTO-2038